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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,102	01/31/2001	Lisa S. Martin	M-9863 US DC-02830	1750
33438	7590	11/16/2004	EXAMINER	
HAMILTON & TERRILE, LLP P.O. BOX 203518 AUSTIN, TX 78720			JASMIN, LYNDIA C	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/773,102

Applicant(s)

MARTIN ET AL.

Examiner

Lynda Jasmin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1,3-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. Amendment received August 19, 2004 has been acknowledged.

***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 19-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to neither a "process" nor a "machine," but rather embrace or overlap two different statutory classes of invention. The claims begin by discussing a system, and the body of the claims discusses the specifics of a method. "A claim of this type is precluded by the express language of 35 U.S.C 101 which is drafted so as to set forth the statutory classes of invention in the alternative only." See MPEP §2173.05(p) II or *Parte Lyell*, 17 USPQ2d 1548 (B.P.A.I., 1990).

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 3-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the recitation "sending electronically an order for the material" is unclear. Are applicants referring to the same order for the material based on the considering? The Examiner suggests the term --the-- instead of "an" before order for clarity.

Also, the recitation "assembling the products" at line 12, lacks proper antecedent basis. Which products are Applicants referring to? Further, at lines 10-13, these limitations are confusing those render the claim indefinite. First, the recitation "the material is not ordered until a manufacturer realizes a demand" renders the claim indefinite since it is unclear how this limitation is connected to the identifying and the sending steps previously recited. Is the manufacturer the one that performs the identifying step? Further, the recitation "wherein a manufacturer realizes the demand for the material after orders are received from customers" is confusing. How is the manufacturer related to the identifying of a supplier or supplier logistics centers? Further are Applicants referring to another manufacturer since a manufacturer was previously recited? **Same remarks for the limitations in claims 8, 14 and 22.**

In claim 3, the recitation "the supplier logistic center receiving the material from a supplier" renders the claim indefinite since it contradicts with the identifying a supplier or a supplier logistics center to receive an order for the material, and sending electronically an order for the material to the supplier or the supplier logistic center identified to receive the order. How can it be received from the supplier when it is sent to either the supplier or the supplier logistics center?

In claim 7, the recitation "from the received at the assembling facility" lacks proper antecedent basis since a step of receiving the material at an assembling facility has not been claimed.

In claim 8, the recitation "wherein a manufacturer realizes..." second occurrence renders the claim indefinite. Are applicants referring the same manufacturer previously recited? Also, the recitation "assembling the products" lacks proper antecedent basis. Which products are Applicants referring to?

In claim 9, the recitation "wherein the material is ordered from a supplier logistics center" is unclear. Are applicants referring to the same supplier logistics center of claim 7? Further the recitation "the supplier logistics center receives the material from a supplier" renders the claim indefinite since it contradicts with the identifying a supplier or a supplier logistics center to receive an order for the material, and sending electronically an order for the material to the supplier or the supplier logistic center identified to receive the order. How can it be received from the supplier when it is sent to either the supplier or the supplier logistics center?

In claim 13, the recitation "considering a quantity of a material" is not positively set forth.

In claim 14, the recitation "by the manufacturer" lacks proper antecedent basis, and the recitation "assembling the products" lacks proper antecedent basis.

In claim 15, the recitation "wherein the material is shipped from a supplier logistics center" is unclear. Are applicants referring to the same supplier logistics center of claim 13? Further the recitation "wherein the supplier logistics center receives the

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material from a supplier” renders the claim indefinite since it contradicts with the identifying a supplier or a supplier logistics center to receive an order for the material, and sending electronically an order for the material to the supplier or the supplier logistic center identified to receive the order. How can it be received from the supplier when it is sent to either the supplier or the supplier logistics center?

Claims 19-25 are directed to neither a “process” nor a “machine,” but rather embrace or overlap two different statutory classes of invention. It is therefore unclear whether Applicant is claiming a process or a machine. See MPEP §2173.05(p) II or *Parte Lyell*, 17 USPQ2d 1548 (B.P.A.I., 1990).

In claim 20, the recitation “wherein when the material is shipped from a supplier logistics center” is unclear. Are applicants referring to the same supplier logistics center of claim 19? Further the recitation “wherein the supplier logistics center receives the material from a supplier” renders the claim indefinite since it contradicts with the identifying a supplier or a supplier logistics center to receive an order for the material, and sending electronically an order for the material to the supplier or the supplier logistic center identified to receive the order. How can it be received from the supplier when it is sent to either the supplier or the supplier logistics center?

In claim 22, the recitation “assembling the products” lacks proper antecedent basis.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. As best understood, claims 1, 3, 5-9, 11-15, 17-20 and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aram (2002/0072986 A1), in view of Tanaka et al. (5,946,663).

Aram discloses a method of ordering and assembling material, comprising: considering a quantity of a material (via suppliers inventory of items, goods, parts and/or sub-assemblies and the like) available from a plurality of suppliers (102) via a computer system, considering a quantity of a material available from a plurality of supplier logistics centers (via distributor 104) via a computer system, identifying a supplier or a supplier logistics center to receive an order for the material based upon the considering

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(via determining the stock level held by relevant supplier or elsewhere; see box 109), and sending electronically an order for the material to the supplier or supplier logistics center identified to receive the order (via emailing the supplier to alert the supplier to a newly logged order; see box 0112). Aram further discloses customers sending order electronically to distributor, and the supplier logistics center (via distributor's warehouse) receiving the material from a supplier (via distributor suppliers or other suppliers).

However, Aram fails to disclose that the material is not ordered until a manufacturer realizes a demand, and a manufacturer realizes the demand for the material after orders are received from customers fulfilling the orders requires assembling the products and assembling the products requires the material.

Tanaka et al. discloses a method and system of planning a production schedule with the concept of rapidly plan a production schedule of operating processes with having a completed product stock allocating step of allocating order information to completed product stock information, and determining an order which is to be subjected to production (hereinafter, such an order is referred to as "order to be produced").

Tanaka et al. further discloses the concept of considering delivery time in the operation request and support an early delivery in response to an order.

From this teaching of Tanaka et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modify the method of ordering goods from a distributor in Aram to include the planning and scheduling of product manufacturing from specific order as taught by Tanaka et al. in order to facilitate production of materials without keeping a large inventory at a processing factory.



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9. As best understood, claims 4, 10, 16 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aram in view of Tanaka, as applied to claims 1, 7, 13 and 19 and further in view of Peterson et al. (6,539,360 B1)

The Aram and Tanaka et al. combination discloses the elements of the claimed invention, but fails to explicitly disclose taking title/ownership by the manufacturer to a material after the material is shipped by a supplier.

Peterson et al. discloses the concept of where suppliers are authorized by the manufacturer of an item to distribute the item.

From this teaching of Peterson et al, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of ordering and distributing goods of the Aram and Tanaka et al. combination to include the manufacturing product ownership taught by Peterson et al. in order to provide complete access of product inventory by a manufacturer.

### ***Response to Arguments***

10. Applicant's arguments with respect to claims 1, 7, 13 and 19 have been considered but are moot in view of the new ground(s) of rejection.

It is Examiner's position that the prior art of record discloses the claimed invention of indefinitely recited.

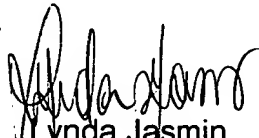
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda Jasmin whose telephone number is (703) 305-

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0465. The examiner can normally be reached on Monday- Friday (8:00-5:30) alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Lynda Jasmin  
Primary Examiner  
Art Unit 3627  
11/14/04

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